United States Court of Appeals for the Federal Circuit

03-1479
(Interference No. 103,662)

CHRISTOPHER J. STEVENS

Appellant,

v.

SHIGERU TAMAI,

Appellee.

Carl E. Moore, Jr., Marshall, Gerstein & Borun LLP, of Chicago, Illinois, argued for appellant. With him on the brief were Sandip H. Patel, Michael R. Weiner, and James P. Zeller.

Edward F. Kenehan, Jr., Armstrong, Westerman & Hattori, LLP, of Washington, DC, argued for appellee. With him on the brief was William F. Westerman.

Appealed from: United States Patent and Trademark Office Board of Patent Appeals and Interferences

United States Court of Appeals for the Federal Circuit

03-1479
(Interference No. 103,662)

CHRISTOPHER J. STEVENS,

Appellant,

v.

SHIGERU TAMAI,

Appellee.

DECIDED: May 4, 2004

Before MICHEL, CLEVENGER, and SCHALL, Circuit Judges.

CLEVENGER, Circuit Judge.

Christopher J. Stevens appeals a final decision of the United States Patent Office Board of Patent Appeals and Interferences ("Board") granting priority in an interference proceeding to Shigeru Tamai. Because the Board erred in granting Shigeru Tamai the benefit of Japanese Patent Application No. 3-068371, we reverse.

I

Christopher J. Stevens ("Stevens") and Shigeru Tamai ("Tamai") are parties to Interference No. 103,662, declared May 9, 1997. Stevens's involved U.S. Patent No. 5,393,368 ("the '368 patent") was filed February 7, 1994, and issued February 28, 1995. Tamai's involved Application No. 08/196,839 ("the '839 application") was filed February 15, 1994. The '839 application is a continuation-in-part of U.S. Patent Application No. 08/030,183 ("the '183 application"), which was filed March 29, 1993. The notice declaring the interference accorded the '839 application the benefit of the filing date of the '183 application. On the basis of the March 29, 1993 filing date, Tamai was accorded senior party status. Both parties filed preliminary motions under 37 C.F.R. § 1.633(f), which provides that a party may file a preliminary motion "to be accorded the benefit of the filing date of an earlier filed application. See § 1.637(a) and (f)." 37 C.F.R. § 1.633(f) (2003). Rule 637 states in relevant part:

> (a) A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. Each motion shall include a statement of the precise relief requested, a statement of the material facts in support of the motion, in numbered paragraphs, and a full statement

> (b) of the reasons why the relief requested should be granted. . . .
> ***
> (f) A preliminary motion for benefit under § 1.633(f) shall:
> (1) Identify the earlier application.
> (2) . . . When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. If the earlier filed application is not in English, the requirements of § 1.647 must also be met.
> (3) Show that the earlier application constitutes a constructive reduction to practice of each count.

37 C.F.R. § 1.637 (2003) (emphasis added). Rule 647 describes what a party must do when relying on or producing a document that is written in a language other than English. It states:

> When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

37 C.F.R. § 1.647 (2003).

Stevens's motion was based on several European applications showing a constructive reduction to practice as early as February 10, 1993. Tamai did not oppose the motion, which was granted by the Board.

Tamai's motion was based on Japanese Patent Application No. 3-68371 ("the Japanese '371 application") and PCT Application No. PCT/JP92/00947 ("the PCT '947 application"). Both applications are in Japanese. Tamai filed a translation of the Japanese '371 application with the motion. Stevens opposed the motion, arguing, inter alia, that Tamai had not met its burden of proof because the motion "failed to comply with 37 C.F.R. § 1.637" because "[n]o copies of [the Japanese '371 application] and the PCT '947 application were served with the motion pursuant to 37 C.F.R. § 1.637(f)(2 [and] [n]o translation of the PCT '947 application was served with the motion pursuant to 37 C.F.R. § 1.637(f)(2." In reply, Tamai stated that copies of the Japanese language applications, the Japanese '371 application and the PCT '947 application, while not served with the motion, were in the record. Tamai also submitted an affidavit attesting that the disclosures of the two foreign language applications were substantially the same. Importantly, with neither the original motion nor the reply did Tamai include an English language translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation.

The Board denied Tamai's motion for benefit as directed to the PCT '947 application because "Tamai did not supply a translation of the PCT application." Nonetheless, the Board examined the Japanese '371 application and determined that the Japanese '371 application "is a constructive reduction to practice of the count." Accordingly, the Board entered judgment against Stevens.

Despite prevailing in the interference, Tamai requested

reconsideration of that part of the Board's decision denying Tamai's motion for benefit as directed to the PCT '947 application. Tamai's request argued that the translation of the PCT '947 application was in the record because the '183 application was in the record and "the U.S. Patent and Trademark Office identified and accepted the '183 application as a translation of Tamai's foreign language PCT application." According to Tamai, the requirements of Rule 647 that "a translation of the document into English and an affidavit attesting to the accuracy of the translation" be provided, were made inconsequential in light of 37 C.F.R. § 1.639(a)[1]. Tamai's final comment in support of its argument, on the last page of the request for reconsideration, states: "[I]f this request is denied, it is respectfully requested that the Board explain how Tamai is entitled to the benefit of the [Japanese '371 application] without the linking PCT application in the chain of priority." Tamai's Req. for Recons. at 7. Stevens opposed Tamai's motion, arguing, *inter alia:*

> Stevens agrees with Tamai's apparent position that the Board erred in granting Tamai priority benefit of [the Japanese '371 application] in

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1
Rule 639a) states, in part:

[P]roof of any material fact alleged in a motion, opposition, or reply must be filed and serves with the motion, opposition, or reply unless the proof relied upon is part of the intereferenmce file or the file of pay patent or applucation involved in the interference or any earlier application filed in the Unitd States of which a party has been accorded or seeks to be accorded benefit.

37. C.F.R. §1.639(a)(2003).

> view of Tamai's failure to satisfy the requirements for obtaining priority benefit of Tamai's PCT application. Because Tamai is not entitled to the priority benefit of the PCT application, the Board also should have denied Tamai's motion for the priority benefit of [the Japanese '371 application].

Stevens's Opp'n to Tamai's Req. for Recons. at 9 (citing 35 U.S.C. § 119(a)).

The Board agreed to reconsider its final decision, but refused to modify it because, "Tamai was required to file a translation of the PCT application along with the motion. This Tamai did not do." Addressing Tamai's argument that the '183 application was the translation of the PCT '947 application, the Board noted that "Tamai did not state that the '183 application is a translation of the PCT application, attaching same, when the motion for benefit was filed." Also, the Board concluded that Rule 637(f) requires that certain documents have to be filed with a motion for benefit and those requirements were not "obviated" by Rule 639(a). Further, the Board concluded that Tamai's failure to follow the rules prejudiced Stevens, who was entitled to expect that Tamai would follow them. Finally, addressing Tamai's linking argument, the Board concluded that any inconsistency in the treatment of the Japanese '371 application and the PCT '947 application "arises because of Tamai's inconsistent actions in regard to these two applications." However, by not modifying its judgment, the Board affirmed its judgment in favor of Tamai. Stevens appeals the decision on reconsideration, which is a final decision of the Board. This court has jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

II

We review factual determinations of the Board for substantial evidence, *In re Gartside*, 203 F.3d 1305, 1311-15 (Fed. Cir. 2000), while we review statutory interpretation *de novo*, *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564 (Fed. Cir. 1997) (construing 35 U.S.C. § 120). We review "the Board's application of its permissive interference rules for an abuse of discretion." *Brown v. Barbacid*, 276 F.3d 1327, 1332 (Fed. Cir. 2002); see also *Abrutyn v. Giovanniello*, 15 F.3d 1048, 1050 (Fed. Cir. 1994); *Gerritsen v. Shirai*, 979 F.2d 1524, 1527-28 (Fed. Cir. 1992). An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision. *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266-67 (Fed. Cir. 2003) (citing *Gerritsen*, 979 F.2d at 1529).

III

On appeal, Stevens argues that the Board erred in granting Tamai's motion for benefit of the Japanese '371 application. According to Stevens, the statutory limits of 35 U.S.C. § 119(a) preclude Tamai directly claiming the benefit of the Japanese '371 application because that application was filed more than one year before the '183 application. In particular, Stevens asserts that in order to obtain the benefit of the Japanese '371 application, Tamai must obtain the benefit of the intervening PCT '947 application. In Stevens's view, because

Tamai failed to prove its claim for priority benefit of the PCT '947 application, and cannot therefore obtain the benefit of the Japanese '371 application, Tamai has failed to prove a constructive reduction to practice of the subject matter corresponding to the count prior to the filing date of the '183 application, March 29, 1993. Based on Stevens's preliminary motion, the Board accorded Stevens an effective filing date of February 10, 1993. Because February 10, 1993 is an earlier effective filing date than March 29, 1993, Stevens argues that he should be awarded judgment in the interference.

Tamai does not argue that his involved application can be accorded the benefit of the Japanese '371 application if he is not accorded the benefit of the PCT '947 application. Rather, Tamai supports the Board's decision in his favor by arguing that the Board erred in not according him the benefit of the PCT '947 application. In particular, Tamai argues that a preliminary motion for benefit is not required for him to be entitled to the benefit of the PCT '947 application, or, alternatively, if a motion for benefit was required, his actions in this case were sufficient to establish entitlement to the benefit of the PCT '947 application.

IV

As a matter of convenience, we first address Stevens's argument. We agree with Stevens: because Tamai failed to prove his entitlement to the benefit of the PCT '947 application, it was error for the Board to accord Tamai the benefit of the Japanese '371 application.

An interference is a proceeding instituted in the United States Patent and Trademark Office, designed to resolve

questions of priority and patentability between two or more parties claiming the same patentable invention. See 35 U.S.C. § 135 (2000); 37 C.F.R. § 1.601 (i) (2003). To establish priority, parties may rely on earlier filed applications because conception and constructive reduction to practice of the subject matter described in an application occur when the application is filed. *See Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998); *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 885-86 (CCPA 1973). If a party is entitled to rely on an earlier filed application and the specification of that application shows a constructive reduction to practice of the count, no further evidence is needed to prove invention as of the filing date of that application. *See Hyatt*, 146 F.3d at 1352.

A party to an interference seeking to be "accorded the benefit of the filing date of an earlier filed application" under 37 C.F.R. 1.633(f) is seeking to establish an effective filing date. *See id.* at 1351-52. "The effective filing date of an application is the filing date of an earlier application, benefit of which is accorded to the application under 35 U.S.C. 119, 120, 121, or 365 . . . ." 37 C.F.R. § 1.601 (g) *see also Hyatt*, 146 F.3d at 1352 ("When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C. § 120..."). Section 119(a) of title 35 precludes relying on a foreign application for priority benefit when that application was filed more than one year before the filing of the corresponding U.S. application. *Schmierer v. Newton*, 397 F.2d 1010, 1014-15 (CCPA 1968). Section 119(a) reads:

> (a) An application for patent for an invention filed in this country by any person who has . . . filed an application for a patent for the same

> invention in a foreign country . . . shall have the same effect as the same application would have if filed in this country on the date on which the application for patent . . . was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed . . . .

35 U.S.C. § 119(a) (2000).

In the matter at hand, the Board held that because Tamai did not file with his motion for benefit an English language translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation, Tamai had not proven that he was entitled to be accorded the filing date of the '947 application. Nonetheless, the Board granted Tamai's involved application the benefit of the Japanese '371 application, which was filed July 31, 1991, more than one year prior to the filing of the '183 application. Because section 119 precludes reliance on a foreign application for priority benefit when that application was filed more than one year before the filing of the corresponding U.S. application, see Schmierer, 397 F.2d at 1014-15, the Board's conclusion was based on an erroneous conclusion of law, and accordingly, constituted an abuse of discretion.

V

At argument, Tamai conceded that he had no theories or evidence remaining before the Board by which to establish an actual or constructive reduction to practice prior to Stevens's February 10, 1993, date. Tamai agrees that if this court does

not grant relief on his argument that a motion for benefit was unnecessary, or alternatively that his motion for benefit was sufficient, then this court should remand for judgment in favor of Stevens. In Tamai's view, a preliminary motion for benefit is unnecessary because 35 U.S.C. § 363 operates to make the filing date of the Japanese language PCT '947 application the same as that of the '183 application, which according to Tamai is the U.S. national stage application of the PCT '947 application. Further, Tamai asserts that even if the Board could require a preliminary motion for benefit, the acts required to enter the national stage for examination purposes were sufficient acts to satisfy the Board's procedural requirements in this interference. Finally, Tamai argues that 37 C.F.R. § 639(a) combined with the presence in the interference file of both the PCT '947 application and the '183 application obviates the requirement of interference rule 37 C.F.R. § 647 that Tamai serve a translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation with the motion for benefit. Because the Board did not err in requiring a preliminary motion for benefit, because Tamai's compliance with the filing procedures for entering the national stage did not satisfy the procedural requirements for a preliminary motion for benefit, because Rule 639(a) does not obviate Rule 647, and because Tamai did not attach to his motion a translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation, we hold that the Board was correct in denying Tamai's claim of benefit of the PCT '947 application. Accordingly, we reverse the Board's decision on reconsideration and remand with instructions to enter judgment in favor of Stevens.

Distilled, Tamai's argument that a motion for benefit was unnecessary in this interference rests on the premise that a motion for benefit cannot be required for non-English applications where the applicant has satisfied U.S. filing requirements for prosecution purposes. In this case, Tamai filed the PCT '947 application with the United States Patent and Trademark Office ("Office") for the purpose of entering national stage examination in the United States. Included with the application was the declaration of Tamai that stated "on information and belief," he was, inter alia, entitled to priority benefit of the Japanese '371 application. The PCT '947 application was accepted by the Office as having satisfied the requirements of 35 U.S.C. § 371 and became the '183 application. Tamai asserts, and we assume without deciding that Tamai correctly followed the procedures for filing the PCT '947 application in the United States. Thus, Tamai argues that when the Office accepts a translation of a foreign language international application into the national stage, the Board, in any interference in which the applicant later becomes embroiled cannot require that the applicant seeking the benefit of the foreign language international application prove that the application contains the same disclosure as the national stage application. We disagree.

In its most favorable light, Tamai is stating that there is a conflict between Subpart E—Interferences, 37 C.F.R. §§ 1.601-1.690, which "governs the procedure in patent interferences in the Patent and Trademark Office," 37 C.F.R. § 1.601, and sections 363 and 371(c)(2) of title 35, as they provide authority for national stage applications.

The conflict Tamai suggests simply does not exist. Sections 363 and 371(c)(2) are not inconsistent with the

Office's procedural requirements which insist that a party to an interference seeking the benefit of an earlier filed application prove the same by filing a motion for benefit, and, where applicable, serving a translation of a relied upon non-English language application with an affidavit attesting to the accuracy of the translation. The former sections deal with accepting an international application into national stage examination in the United States while the latter regulations deal with proving whether the application contains a constructive reduction to practice of subject matter corresponding to a count in an interference. In short, in the context of this case, sections 363 and 371(c)(2), and 37 C.F.R. §§ 1.601-1.690, have little to do with one another.

Section 363 of title 35 establishes that: "An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office . . . ." Subject to 35 U.S.C. § 119(a)-(d), section 365(a) of title 35 grants national applications the benefit of corresponding international applications which designated at least one country other than the United States. Section 371(c)(2) requires that an applicant filing a national stage application submit "a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language." 35 U.S.C. § 371 (c)(2) (2000). And, while overlooked by Tamai, 35 U.S.C. § 372(b)(3) permits the Director to "require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other

than English." Thus, contrary to what Tamai suggests, the Office is not required to accept an applicant's transmittal letter requesting entry into the national stage as conclusive proof that a foreign language application contains a particular disclosure.

Further, as we have previously held, the broadest of the Office's rulemaking powers is the power to "establish regulations, not inconsistent with law, which—(A) shall govern the conduct of proceedings in the Office." 35 U.S.C. § 2(b)(2)(A) (2000) (formerly at 35 U.S.C. § 6(a) (1988), see *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549 (Fed. Cir. 1996); Gerritsen, 979 F.2d at 1527). By this grant of power we understand Congress to have "delegated plenary authority over PTO practice, including interference proceedings," to the Office. *Gerritsen*, 979 F.2d at 1527 n.3. The interference rules most pertinent to this case are 37 C.F.R. §§ 1.633(f), 1.637(a) (establishing that the movant has the burden of proof), 1.637(f) (requiring compliance with 1.647 where the earlier filed application is not in English), and 1.647 (requiring, when the earlier filed application is not in English, the filing of "a translation of the document into English and an affidavit attesting to the accuracy of the translation"). We observe that all of these rules appear to reflect a permissible exercise of the Office's authority and also note that Tamai presents no arguments to the contrary.

The interference regulations are designed to serve the policy of providing "the just, speedy, and inexpensive determination of every interference." 37 C.F.R. § 1.601. It seems appropriate to us that the Office can allocate the burdens associated with this goal in a reasonable manner not inconsistent with the existing statutory scheme. *See Merck & Co.*, 80 F.3d at 1549; *Gerritsen*, 979 F.2d at 1527. In the case

of interferences, the Office has provided for a motion procedure that permits a party an opportunity to prove his right to priority benefit of an earlier disclosure. See 37 C.F.R. §§ 1.633(f), 1.637(a), (f). This includes an opportunity to prove priority to foreign language applications. Because a party seeking to be accorded the benefit of a foreign language disclosure is often in the best position to know the content of the disclosure, and because that party hopes to benefit from the content of that disclosure, it seems very reasonable that a party seeking to rely on such a disclosure have the burden of proving its content. In contrast to Tamai's thinking, the Board can require that the cost of a translator capable of attesting in an affidavit that the disclosure of a Japanese language document, i.e., the PCT '947 application, is the same as the disclosure of a national stage application that purports to be substantially the same, i.e., the '183 application, shall be borne by the party asserting that the latter is an accurate translation of the former.

In view of the reasonableness of the Office's rules governing the procedure in patent interferences, and the substantial deference we accord such rules, see *Merck & Co.*, 80 F.3d at 1549, we cannot agree with Tamai that section 363 overwhelms the Office's interference rules and requires the Board to accord Tamai the benefit of the PCT '947 application merely because he completed the requirements for entering the national stage of examination in the United States.

B

Next, Tamai asserts that the acts necessary to comply with the procedures he followed in the course of entering the national stage of examination are a sufficient substitute for the acts required by the Office's interference rules. In light of our

conclusion that the interference rules at issue are a reasonable exercise of the Office's procedural rulemaking, we hold that the acts Tamai took with regard to entering the national stage will only suffice to satisfy the requirements of the interference rules if the acts show compliance with the interference rules. Accordingly, this is a question of the Board's application of its interferences rules, an exercise we review for abuse of discretion. *See, e.g., Barbacid*, 276 F.3d at 1332.

The interference rules are quite explicit and we discern no abuse of discretion in the Board's decision that Tamai did not comply with Rules 637(f) and 647. In particular, the Board found that "Tamai did not supply a translation of the PCT application." In its decision on reconsideration, the Board affirmed this fact, stating: "Tamai was required to file a translation of the PCT application along with the motion. This Tamai did not do." This finding of the Board is supported by more than substantial evidence. At argument, Tamai conceded that he did not file with his motion for benefit an English language translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation as required by Rule 647.

In his motion for reconsideration below Tamai argued that the '183 application was the translation of the PCT '947 application. However, the Board explained why that argument fails. In particular, the Board found that in neither Tamai's preliminary motion for benefit nor in reply to Stevens's opposition thereto did Tamai "state that the '183 application is a translation of the PCT application, attaching same, when the motion for benefit was filed." Because on its face Tamai's motion for benefit does not state that the '183 application is the translation of the PCT '947 application and the record contains

no affidavit attesting that the '183 application is an accurate translation of the PCT '947 application, this finding is supported by substantial evidence.

Tamai next argues that to comply with section 363, he needed to comply with section 371(c)(2), which requires a translation of the corresponding international application when that application is not in English. According to Tamai, when he presented the Office with a translation of the international application to enter national stage examination that act was sufficient to satisfy Rules 637(f) and 647. As the Board pointed out, however, section 371(c)(2) does not require an affidavit attesting to the accuracy of the translation, while Rule 647 does. Moreover, as our prior discussion indicates, compliance with filing requirements is not sufficient to prove constructive reduction to practice in an interference proceeding.

On appeal, for the first time, Tamai argues that the notice declaring the interference should have accorded him the benefit of the Japanese '371 application and the PCT '947 application. In light of our prior discussion, we think this a matter of the Board's discretion. The Board might, where an international application is in English, and therefore easily accessible in substance to the Board, accord priority to such an application in its notice declaring an interference. However, we discern no requirement that the Board do so in every case, and no requirement that the Board do so when the application is in a foreign language, which makes it more difficult for the Board to determine whether the disclosure contains a constructive reduction to practice of the invention. In a case where the applicant should be accorded the benefit of an earlier application, but the Board does not accord benefit in the notice declaring the interference, the Board has, by regulation,

provided the procedural protection of a preliminary motion procedure. Under that procedure a party can prove that it should be accorded the benefit of an earlier disclosure. That Tamai understood and had access to this procedural protection is underscored by the fact that Tamai filed a preliminary motion seeking to be accorded the benefit of the Japanese '371 application, the PCT '947 application, and the '183 application.

C

Tamai also argues that although he never made known to the Board or Stevens that a translation of the PCT '947 application existed in the interference file as the '183 application, Rule 639(a), which requires that "proof of any material fact . . . be filed and served with the motion . . . unless the proof relied upon is part of the interference file . . . ," 37 C.F.R. 1.639(a), protects him from having to file a translation and affidavit as required by Rules 637(f) and Rule 647. We disagree.

As a preliminary matter, the Office's interpretation of its own regulations is entitled to substantial deference. *Bd. of Regents of the Univ. of Wash.*, 334 F.3d at 1266. On reconsideration, the Board addressed this argument holding that Rule 639(a) does not obviate Rules 637(f) and 647. Given that Rules 637(f) and 647 are very clear in requiring the filing of a translation and affidavit with the preliminary motion for benefit, we defer to the Board's interpretation that Rule 639(a) and Rules 637(f) and 647 are separate rules that must be followed by parties to an interference. Moreover, we note that Tamai's argument on this point is undercut by the fact that his motion and reply did not notify the Board or Stevens that the '183 application was the translation of the PCT '947

application. Had Tamai alerted the Board and Stevens to the presence of the translation, and filed an affidavit attesting that the '183 application was an accurate translation of the PCT '947 application, the Board might have been more lenient.

VI

We have considered Tamai's remaining arguments and we find them either irrelevant or unpersuasive. In conclusion, we find that the Board did not abuse its discretion in refusing to award Tamai the benefit of the PCT '947 application. However, because Tamai was not entitled to the benefit of the PCT '947 application, the Board erred in awarding Tamai the benefit of the Japanese '371 application. Without the benefit of the PCT '947 application and the Japanese '371 application, Tamai's effective filing date, showing a constructive reduction to practice, is March 29, 1993. Because the Board granted Stevens's motion for benefit, according him an effective filing date of February 10, 1993, Stevens has proved a constructive reduction to practice earlier in time than Tamai. Accordingly, we remand to the Board with instructions to enter judgment for Stevens.

COSTS
No costs.

REVERSED AND REMANDED

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

CHRISTOPHER J. STEVENS,

Junior Party,
(P.N. 5,393,368)

V.

SHIGERU TAMAI,
Senior Party.
(S.N. 08/196,839)

Patent Interference No. 103,662

Before: CRAWFORD, GARDNER-LANE, and MEDLEY, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

FINAL DECISION

This interference was declared on May 9, 1997. Tamai's involved application Serial No. 08/196,839 was filed on February 15, 1994. Stevens' involved U.S. Patent No. 5,393,368 was filed on February 7, 1994 and issued on February 28, 1995. At the time this interference was declared, Tamai was accorded the benefit of U.S. Serial No. 08/030,183 ("'183 application") which was filed March 29, 1993 and was accorded senior party status on that basis. Stevens filed a reissue application Serial No. 08/940,815 on September 30, 1997. Stevens' reissue application was added to this interference on September 28, 2000.

The invention at issue in this interference relates to a correction tape dispenser. The particular subject matter in issue is illustrated by count 1, the sole count, as follows:

> A correction tape dispenser comprising:
>
> a tape comprising a carrier ribbon with correction composition thereon,
>
> supply and take—up spools for the tape,
>
> a tip having an edge for pressing the tape against a s u r face
>
> a portion of the tape between the supply and take-up spools being guided to extend around said edge
>
> wherein the edge is inclined to a feed direction which is the direction of travel of the the tape leaving the supply spool, and
>
> the tip includes guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to

the feed direction.

The claims of the parties which correspond to this count are:

Stevens' patent: Claims 1 though 5, 7 through 16 and 18 through 21.

Stevens' reissue application: Claims 1 through 5, 7 through 16 and 18 through 21.

Tamai's application: Claims 1 through 21.

The following matters are before us for review:

(a) Stevens' motion under 37 CFR § 1.633(a) for judgment.

(b) Stevens' motion under 37 CFR § 1.633(f) to be accorded the benefit of earlier filed priority applications.

(c) Stevens' motion under 37 CFR § 1.633(g) to deny benefit of earlier filed application to party Tamai accorded in notice of interference.

(d) Tamai's motion under 37 CFR § 1.633(f) for benefit of earlier filed foreign priority applications.

(e) Stevens' motion under 37 CFR § 1.633(c) to redefine interference subject matter by designating claims of Stevens' U.S. Patent 5,393,368 as not corresponding to the count.

(f) Stevens' motion to suppress evidence pursuant to 37 CFR § 1.656(h)

(g) Stevens' objections to evidence of Senior party Tamai.

Redeclaration

The count as originally filed is identical to Stevens' claim 1 and Tamai's claim 20. The claims, however, include means plus function language i.e.:

> guide means on either side of the edge which operate in conjunction with the shape of the tip

> for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to the feed direction.

When an element in the claim is expressed as a means for performing a specified function, the claim shall be construed to cover the corresponding structure described in the specification and equivalents thereof. 35 U.S.C. § 112, paragraph six. Thus, it is possible to have two identical claims with slightly different meanings.

This interference is hereby redeclared, so that the count is the disjunctive alternative union of Stevens' claim 1 and Tamai's claim 20.

The claims of the parties that correspond to the count remain the same.

Thus, for purposes of the priority, a party may demonstrate priority with respect to Stevens' claim 1, which will be interpreted in view of the Stevens specification, or with respect to Tamai's claim 20, which will be interpreted in view of the Tamai specification.

Stevens' Motion under § 1.633(a):

Stevens seeks to have the interlocutory order denying its motion under CFR. § 1.633(a) modified. Stevens argues in this motion that claim 20 of Tamai's involved application is unpatentable under 35 U.S.C. § 112, first paragraph, because, in Stevens' view, the Tarnai application does not contain a written description of the subject matter of claim 20. Stevens also argues that the disclosure of the Tamai application does not enable a person of ordinary skill in the art to make and use

the invention.

As this is a substantive issue, we review this interlocutory order *de novo*.

Written Description

In regard to the written description requirement, Stevens argues that the Tamai description does not disclose:

> the tip includes guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to the feed direction.

Specifically, Stevens argues that Tamai does not describe a tip which includes a guide means on either side of the edge which operates in conjunction with the shape of the tip for twisting the tape. In Stevens' opinion, the head 18 of the Tamai device is the only portion of the Tamai device that can be called the tip. Stevens argues that head 18 does not have guide means on either side of the edge. In Stevens' opinion, the flanges 33 are the only guide means on the side of head 18 and these flanges 33 do not perform any twisting function.

Central to Stevens' argument is their contention that the tip in Tamai is the head 18.

We note that in construing claims in an interference for purposes of a motion under 37 CFR § 1.633(a), the claim is construed in light of the specification of the application in which it appears. As such, we will construe the term "tip" iii

claim 20 of the Tamai application in light of the disclosure of the Tamai application.

The Tamai application does not explicitly describe a tip. However, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The Tamai application describes a correction tape dispenser having supply and take-up spools, 15 and 16 respectively. The tape is fed out of the supply spool 15 guided on its path by pin 21, guide pin 22, a slit 20 and a flange 33 to arrive at head 18. The tape is then guided on its path from the head 18 by the other flange 33, the other slit 20 and the other guide pin 23 to arrive at the take-up spool 16.

Stevens argues that the term "tip" which is recited in claim 1 of Stevens is the tip 10. Therefore, the tip which is recited in claim 20 of the Tamai application must be the head 18.

We do not agree with Stevens that the tip recited in claim 1 of the Stevens patent is necessarily the tip 10. In cur view, the recitation of a "tip" in claim 1 of Stevens is broad enough to refer to the tip member 10. This interpretation is especially compelling to us in view of the recitation in claim 6 of the Stevens patent of a unitary member. However, as we stated above, claim 20 of the Tamai application is construed in

light of the Tamai application for the purposes of a § 1.633(a) motion. As the Tamai application does not expressly define a tip, this term is given its customary meaning. We note that the Webster's Third New International Dictionary (G&C Meriiam Co., 1981) defines "tip" as "a pointed or rounded extremity of something" and defines an extremity as "an outlying or terminal part, section or point." When claim 20 is given its broadest reasonable interpretation, we find that the term "tip" is broad enough to include the section of the device below the take-up spool 16.

In the Tamai device, the tape is guided on its path below the take-up spool 16 by guide means 22 and 23, slits 20, and flanges 33. As such, these elements together form the guide means recited in claim 20.

The tape leaving guide pin 21 is guided and twisted by the combination of actions of the guide pins 22, 23, flanges 33 and head 18. Stevens argues that this twisting is done solely by the pins 22, 23. We do not agree because the twisting of the tape could not he accomplished without the anchoring actions of slits 20 and flanges 33. The twisting would also not be achieved without the overall configuration or shape of the tip of the device. In addition, the shape of the head 18, which is a portion of the tip, guides the tape so that it is traveling in a plane substantially parallel to the edge of the device.

In regard to the language that the path of the tape around the edge is inclined to the feed direction, Stevens argues that this feed direction is the direction of the tape as it leaves the guide pin 22 and that because the tape is traveling parallel to the axis of the device as it leaves pin 22 and also traveling to the head 18 in a direction parallel to the axis of the device, the path of the tape is not inclined to the feed direction.

Claim 20 recites that the feed direction is the direction of travel of the tape leaving the supply spool. In the Tamai device, the tape leaves the supply spool 15 at an angle with respect to the axis of the device while the tape travels parallel to the axis of the device as it travels to the head 18. As such, the path of the tape is clearly inclined to the feed direction as it travels to the head.

Enablement:

In regard to the question of enablement, Stevens argues that there is no guidance in the Tamai disclosure of how to provide guide means in the head 18 which Stevens views as the tip. As we have stated above, the tip language in claim 20 is broad enough to include the portion of the Tamai device which is below the take—up spool 16. As the guide means includes pins 22, 23, slits 20, and flanges 33, the guide means is disposed at least in part on either side of the edge of the device. Accordingly, Tamai does include a description that would enable one of ordinary skill in the art to make or use a guide means on either side of the edge.

Stevens also argues that there is no recognition that the peak portion of the head 18 is inclined relative to the tape feed direction to allow the coating file transfer tool to be angled forwardly and downwardly in a pen like manner in use.

We note initially that claim 20 does not recite that the coating film transfer tool in use is angled forwardly and downwardly in a pen like manner. Therefore, this portion of the argument is not persuasive because it is not commensurate with the actual scope of claim 20. Furthermore, as stated above, the edge of the head 18 is disposed parallel to the case body and the tape leaves spool 15 at an angle to the axis of the device. Thus, head 18 is inclined relative to the tape feed direction.

Stevens further argues that the Tamai application lacks sufficient information on the construction of the tape dispenser to enable a person of ordinary skill in the art to make and use the claimed invention. Specifically, Stevens argues that the Tamai application contains no explanation of how the peak portion 32 of the head 18 is supported by the case 11.

An analysis of whether the claims are supported by an enabling disclosure requires a determination of whether that disclosure contains sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. *See United States v. Telectronics,* Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Fir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

Thus, the dispositive issue is whether Tamai's disclosure, considering the level of ordinary skill in the art as of the date of Tamai's application, would have enabled a person of such skill to make and use the Tamai device without undue experimentation.

In our view, Stevens has not met its burden with respect to this aspect of the enablement issue because Stevens has not even addressed the issue of whether a person of ordinary skill in the art would have known how to attach the head 18 to the case 11 without undue experimentation. In other words, even though the connection of the head 18 to the case 11 is not explicitly disclosed in the Tamai application, Stevens has the burden of establishing that a person skilled in the art would not

have known how to secure the head 18 to the case without undue experimentation. This Stevens has not done and as such this portion of the enablement argument also fails.

In view of the foregoing, we will not modify the interlocutory order denying Steven's motion under 37 CFR. § 1.633(a).

Tamai's benefit application

In the notice declaring this interference, Tamai was accorded the benefit of an application Serial No. 08/030,183 filed March 29, 1993 ("183 application"). Stevens has filed a motion under 37 CFR 1.633(g) requesting that Tamai be denied benefit of this application because in Stevens' opinion, Tamai's application does not contain adequate support for the following claim limitation:

> the tip includes guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to the feed direction.

In order to prevail on this motion, Stevens must prove that the '183 application does not describe an embodiment within the scope of the count. *Hunt v. Treppschurch*, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975)

Before this motion can be analyzed, we must first construe the elements included in the count. Specifically, we must interpret what is meant in the count by the language "tip," "guide means," and "inclined to the feed direction."

We note that Stevens has compared the language of claim 20 of the Tamai application with the disclosure of the '183 application and asserts that Tamai's claim 20 is not supported by the '183 application.

Benefit for the purposes of priority in an interference declared under 35 U.S.C. § 135 (a) is something different than benefit for the purpose of overcoming prior art. *Anderson v. Norman*, 185 USPQ 371, 372 (Comm'r Pat. 1968). A benefit application need only describe a single enabled embodiment within the scope of the count to constitute a constructive reduction to practice of the invention of the count. *Hunt v. Treppschurch*, 523 F.2d at 1389, 187 USPQ at 429; see also Well v. Fritz, 572 F.2d 856, 865 n.l6, 196 USPQ 600, 608 n.l6 (CCPA 1978)

For an earlier-filed application to serve as constructive reduction to practice of the subject matter of an interference count, the earlier application must reasonably convey that the inventor had possession at the time of the later claimed subject matter.

It is well settled that counts should be given their broadest reasonable interpretation and that only when there is ambiguity can resort be had to the specification. *Reese v. Hurst*, 661 F.2d 1222, 1236, 211 USPQ 936, 949—50 (CCPA 1981) *In re Baxter*, 656 E.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981) . We note that broad count language is not ambiguous merely because it reads or-i more than one embodiment. *Kroekel v. Shah*, 558 F.2d 29, 32, 194 USPQ 544, 547 (CCPA 1977) . Nor is an ambiguity established by the fact that the parties offer different interpretations of the count. The rationale for this reasoning is that when an applicant selects language which is somewhat broad in scope, he takes the risk

that others with specifically different structures may be able to meet the language selected; he will not be permitted to later urge that the selected language should only be read in light of his disclosure merely because the language originated with him. *Hemstreet v. Rohland*, 433 F'.2d 1403, 1406, 167 USPQ 761, 763 (CCPA 1970)

The count includes a tip having an edge for pressing the tape against the surface. Stevens has not established that this language is ambiguous. In fact, Stevens has not addressed the ambiguity of the count language in their opening brief. In the reply brief, Stevens argues that if an ambiguity exists, it arises from the interpretation given the term tip" by the interlocutory order and by Tamai. However, Stevens must prove that there is an ambiguity in the count language itself to warrant resort to the Stevens specification to interpret the count.

We do not find that there is ambiguity in regard to the language in the count directed to the tip and as such, we will give this language its broadest reasonable interpretation.

In regard to the language "guide means on either side of the . . . tip . . . for twisting the tape" which is set out in means plus function format, it is interpreted in view of the specification of the Tamai application or the Stevens parent in view of our Redeclaration.

When interpreted in view of the Tamai specification, this language refers to the operation of the guide pins 22, 23, flanges 33 and slits 20 which are disposed on either side of the tip (the portion of the device below reel 16) as we discussed above in our analysis of the Stevens' motion under 37 CFR § 1.633(a).

When interpreted in view of the Stevens specification, this language refers to the prepositioning posts 7, 8, and 9, the guide ridges 11 and 12 in the embodiment disclosed in Figure 1 and it refers to the guide pegs 22 and 23 and the wings 16 in the embodiment disclosed in Figure 8. We note that Stevens refers to posts 7, 8, and 9 as guiding means (col. 3, lines 25 to 30).

In regard to the language "the edge is inclined to a feed direction which is the direction of travel of the tape leaving the supply spool," there is no ambiguity. In our view, this language refers to the direction the tape is traveling as it leaves the supply spool 3 in Stevens and the direction the tape is traveling as it leaves the supply spool 15 in Tamai.

The '123 application

Stevens specifically argues that the '183 disclosure does not disclose the unique tip construction of the count.

Stevens argues that the tip which is disclosed in the '183 application is the head 18 and that the head 18 does not include guide means on either side of the edge. As we stated above, we do not agree that the tip which is recited in the count must be construed so narrowly. In our view, the term "tip" is broad enough to encompass more than the head 18. Specifically, the term tip may be interpreted to include the portion of the '183 device below the reel 16.

Stevens argues that the term "tip" as defined by Webster's Third New International Dictionary is a small piece or (as a belt, shoe, cane, pen or billiard cue) designed to serve as an end, cap or point and made usually of metal, leather, or other durable substance. Stevens then concludes that only peak portion 32 of head 18 is the tip. We must point out that the

proceeding dictionary definition indicates that the tip may be a part which serves as an end. In addition, the first definition given for "tip" in Webster's Third New International Dictionary as we discussed above is "a pointed or rounded extremity of something" and further defines extremity as "an outlying or terminal part, section or point" . When this broad definition is considered, it is clear that the broadest reasonable construction of the term "tip" would include the tip member 10 in the Stevens device and the portion below the reel 16 in the Tamai device.

Stevens views the ridges 11 and 12 disclosed in Stevens to be the only elements in the Stevens device which comprise the guide means of the count.

However, Stevens discloses:

> A length of tape extending between the supply and take- up spools is guided to pass around the tip edge 6. The guiding means include tape positioning means provided by posts 7, 8, and 9 . . . [col. 3, lines 23 to 27].

Therefore, in our view the guide means in the first embodiment disclosed in Stevens is a combination of elements, namely, the prepositioning posts 7, 8, and 9 and the ridges 11 and 12. In addition, the guide means that is disclosed in the embodiment disclosed in Figure 8 includes pegs 22 and 23 and wing projections 16 which is very similar to the guide means disclosed in Tamai.

In any case, in view of our redeclaration in this interference, the guide means language can be interpreted in terms of the Tamai disclosure or the Stevens disclosure. When

this language is interpreted in view of the Tamai disclosure, it is clear that the guide means of the count is disclosed in the '183 specification as guide pins 22 and 23, slits 20 and flanges 33 as these elements operate to guide the travel of the tape.

In regard to the language about the direction of travel of the tape leaving the spool, Stevens argues that the '183 disclosure is totally devoid of any discussion of the tape feed direction and the relationship of the tape feed direction to the peak portion 32 of the head 18.

While it is true that the '183 disclosure does not specifically discuss the relationship of the travel of the tape leaving the spool and the edge of the tip, it is clear from Figure 1 of the '183 disclosure, that the tape leaves the feed reel at an inclined angle with respect to the plane of the edge.

Stevens also argues that the '183 application does not meet the enablement requirements of 35 U.S.C. § 112. Steven's argument in regard to enablement is that the '183 application does not explain how to provide guide means on the head 18 and how to arrange the guide means on the head 18 to cooperate with the shape of the head to achieve the travel of the tape in the desired path perpendicular to the peak portion 32 and inclined to the feed direction.

As we have interpreted the tip language of the count to be broad enough to include the portion of the device below the winding reel, we do not find this argument persuasive. The tip of the '183 as depicted in Figure 1, includes the guide means as recited in the count as we have discussed above.

In view of the foregoing, the Junior party's motion to deny the Senior party's benefit in the '183 application is

denied.

Tamai's PCT and JP applications

Tamai has moved for the benefit of earlier filed PCT and Japanese applications. Tamai has identified the applications as Japanese Patent Application No. 3-68371 ("JP '371'fl and PCT Application No. PCT/JP92/00947 ("PCT application"). The PCT application is part of the file wrapper of the '183 application and JP '371 is part of the file wrapper for the involved Tamai application and the '183 application. Translation of the JP '371 application is part of the file wrapper of the involved Tamai application. A copy of the translation of the JP '371 application was attached with the motion. Copies of translations of these documents were served on Stevens with the Reply to the Opposition to this motion.

The motion indicates that the written specification of the JP '371 and the PCT application are substantially identical to the specification of the '183 application and that the drawings of the JP '371 application and the PCT application are exactly identical to the drawings of the '183 application and that thus Tamai is entitled to the benefit of the JP '371 and PCT application for the same reasons that it is entitled to the benefit of the '183 application.

Stevens has opposed this motion stating that (1) Tamai has failed to submit a copy of the JP '371 and PCT application with the motion, (2) Tamai failed to make a showing that the JP '371 and PCT application constitute a constructive reduction to practice of the count and (3) no statement of material facts was submitted by Tamai to support the motion.

It is true that Tamai did not file a copy of the JP '371 and PCT applications, or a translation of the PCT application

with the motion. Tamai did file a translation of the JP '371 application with the motion. In fact, Stevens analyzes the subject matter disclosed in the JP '371 application in its opposition with reference to the translation of the JP '371 application. In addition, copies of both applications are a part off the file wrapper of the '183 application and a translation of the JP '371 application is part of the file wrapper for the involved application. As such, Stevens did have access to the copies and translations of the JP '371 at the time of the motion. Therefore, Tamai's failure to submit copies of the JP '371 application and its translation did not prejudice Stevens. As such, in the interest of justice, we will consider the motion as it is directed to JP '371.

However, Tamai did not supply a translation of the PCT application, nor does it appear that Stevens was in possession of the application or the translation. Although Tamai alleges that the PCT application has the same disclosure as the JP '371 and submitted a declaration executed by Sadao Kinashi attesting to the fact that the disclosures of the PCT application and JPO '371 are the same, Stevens was not given the opportunity to examine the disclosures and translations for themselves. Therefore, we will not grant the motion as it is directed to the PCT application.

In regard to Stevens' allegation that the motion failed to include a statement of material facts and to prove that the disclosure of the JP '371 application is a constructive reduction to practice of the count, we disagree. The motion clearly states that the drawings of the JP '371 application are identical to the drawings of the '183 application. We note that Figure 1 of the JP '371 application and Figure 1 of the '183 application are identical. And from this figure, it is clear that the '183 device includes the elements of the count. Tamai also argues that the

specification of the JP '371 application is substantially identical to the specification of the '183 application. As such, in our view, Tamai did include in the motion a statement of material facts to prove that the disclosure of the JP '371 application is a constructive reduction to practice of the count.

Stevens also argues that the disclosure of the JP '371 application does not meet the requirements of 35 U.S.C. § 112, first paragraph, because in Stevens' opinion, the disclosure does not contain a written description of the invention of the count and does not enable a person of ordinary skill in the art to make and use the invention of the count. Specifically, Stevens argues that the disclosure of the JP '371 application does not include a guide means on either side of the Lip which operates with the tip shape to twist the tape, the tape path is not in a plane substantially perpendicular to the tip edge and that the JP '371 application does not enable a person of ordinary skill in the art to include a guide means in the tip of the device. We do not agree with this analysis for the reasons stated above in our discussion of Tamai's preliminary motion for benefit for the '183 application.

For the foregoing reasons, we will grant the Senior party's motion for benefit as it is directed to the JP '371 application but will deny this motion with regard to the PCT application.

Motion to suppress and Objections to evidence:

Stevens has objected to and moved to suppress the JP '371 and the translation of JP '371 which are Exhibits 6 and 7 respectively. Stevens argues that Tamai did not certify in the Preliminary Motions under 37 CFR. § 1.633(f) that the copy of the JP '371 was served on Stevens as is required by 37 CFR § 1.637(f) (2) As we stated above, while it is true that Tamai did

not file a copy of JP '371 when the preliminary motion to he accorded the benefit of the filing date of JP '371 was filed, a translation of the document was served with the motion and the document itself was a part of the file wrapper of the '183 application which Stevens had access to. Therefore, in our opinion, it is in the interest of justice that this document be considered as evidence.

Stevens also argues that Tamai has failed to establish that this document is a constructive reduction to practice of the count. However, this argument goes to the sufficiency of the document rather than whether the document should be entered as evidence. In any case, as we discussed above, it is our view that Tamai has established that the JP '371 application is a constructive reduction to practice of the count.

Stevens has also moved to suppress the translation of JP '371 because in Stevens' view, Tamai did not show that the translation constitutes a reduction to practice of the count. We do not agree for the reasons stated above.

As such, we consider JP '371 as evidence in spite of the objections of Stevens and the motion as it is directed to JP '371 and its translation is denied.

The motion and the objections are also directed to various other exhibits of Tamai but as these exhibits are not relied on in making our decision, the motion and objections in regard to these other exhibits are moot.

Therefore, Tamai has established a constructive reduction to practice of the count as of July 31, 1991.

Stevens' motion for benefit

Stevens has moved for benefit of the filing date of several European applications. The motion is unopposed. Therefore, we will grant Stevens' motion for benefit. As such, Stevens has established a constructive reduction to practice of the count as of February 10, 1993.

Stevens' motion to redefine:

Stevens seeks review of the interlocutory order that denied its motion to redefine the interfering subject matter by designating claims 2 to 5, 7 to 16 and 18 to 21 as not corresponding to the count. Stevens alleges that the APJ failed to consider the declaration of Joseph Vallera or to analyze the dependent claims.

We note that a party has the burden of establishing by a preponderance of the evidence that any argued claim is separately patentable or patentably distinct with respect to the prior art in accordance with the guidelines set forth in *Graham v. John Deere*. *See* 37 CFR § 1.637(c) (4) (ii) and § 1.601(n). Mere reference to a claimed feature which is not disclosed by the prior art and not included in the count does not per se establish "separate patentability" within the meaning of § 1.601(n). Rather, the question is whether that feature would have been obvious to a person of ordinary skill in the subject art. For example, we note that Stevens does not allege that he knows of no prior art that would render its claims 1 through 5, 7 through 16 and 18 through 21 unpatentable over Tamai's claims.

In regard to claims 2 to 4 and 7 to 10, Stevens argues that the particular features of these dependent claims are not included in the count. With reference to the Form 850, in regard to claims 5, 11 to 16 and 18 to 21, Stevens argues that

neither the count nor JP 63—56690 includes or discloses the particular features of the count. However, Stevens has not established that the features that are recited in these claims render the claims separately patentable from any other claim whose designation to the count Stevens does not dispute. Stevens has failed to present any evidence that the claimed configurations are something more than obvious variations well within the ordinary skill of those versed in the art. Nor has Stevens established or even argued that the use of the claimed configurations in lieu of that disclosed in the prior art solves a particular problem or otherwise provides a particular benefit. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975)

For example, claim 2 recites that the guide means comprises a linear edge around which the tape passes from one side to the other side. Stevens argues that the count does not include such a linear edge. Stevens has not established that this edge has patentable significance. In this regard, we note that the other embodiments disclosed in Stevens do not include such an edge (see Figures 6 to 9) . In addition, Stevens has not pointed to any portion of the specification, and we can find none, which establishes that the provision of the linear edge as the guide means solves any problems or produces any unexpected results.

In regard to claim 5, for example, Stevens argues that neither JP 63-56690 nor the count includes tape positioning means to determine a first fixed position from which the tape passes to the tip in the feed direction. While this may be so, Stevens has not established that the provision of the fixed position solves any problem or produces any unexpected result and would therefore render claim 5 separately patentable. Again, as we view the embodiment in Figures 6 and 7, no such fixed position is provided.

Stevens directs our attention to the declaration of Joseph Vallera (JP record, tab 2) which the Junior party asserts was misconstrued by the examiner and incorrectly applied to Stevens' claims 5, 11 to 16 and 18 to 21. Stevens does not indicate where such analysis is located in the Vallera declaration. We have reviewed the Vallera declaration and fail to find an analysis of how the JP 63—56690 reference relates to the subject matter of claims 5, 11 to 16 and 18 to 21. The Vallera declaration does discuss the JP 63—56690 reference on page 17 but only discusses what the JP 63-56690 reference teaches. The Vallera declaration does not discuss claims 5, 11 to 16 and 18 to 21 in relation to the JP 63—56690 reference. The Vailera declaration does not discuss the obviousness of the features recited in claims 5, 11 to 16 and 18 to 21.

In view of the foregoing, we will not modify the interlocutory order denying this motion.

Judgment

Because Tamai has established a constructive reduction to practice of July 31, 1991 and Stevens has established a constructive reduction to practice of February 10, 1993, judgment is herein entered against Stevens.

Accordingly, Stevens is not entitled to claims 1 through 5, 7 through 16 and 18 through 21 of their involved patent or of claims 1 through 5, 7 through 16 and 18 through 21 of their reissue application which correspond to the count.

In view of the Redeclaration of the interference (*supra* at 4—5) , the parties shall, within the time set for requesting reconsideration under 37 CFR § 1.658(b) present any arguments for reconsideration and, if the parties present any

new arguments, explain why the arguments are necessitated by the Redeclaration.

_____/s/_____
Murial E. Crawford
Administrative Patent Judge

_____/s/_____
Sally Gardener-Lane
Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

CHRISTOPHER J. STEVENS,

Junior Party,
(P.N. 5,393,368)

V.

SHIGERU TAMAI,

Senior Party.
(S.N. 08/196,839)

Patent Interference No. 103,662

Before: CRAWFORD, GARDNER-LANE, and MEDLEY, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge

DECISION ON REQUEST FOR RECONSIDERATION

Tamai has requested reconsideration and modification of our FINAL DECISION mailed June 25, 2002 (hereinafter, Decision) Specifically, Tamai seeks reconsideration of that portion of the Decision that denied Tamai's motion for benefit as it relates to PCT Application No. PCT/JP92/00947 ("PCT application"). Stevens opposes the request. For the following reasons, Tamai's request for modification of the Decision is denied.

In our Decision, we noted that the PCT application is part of the file wrapper of Tamai's application Serial No. 08/030,183 ("'183 application"). Tamai was accorded the benefit for purposes of priority of the '183 application.

Section 1.637(f) of 37 CFR states in relevant part: A preliminary motion for benefit under § 1.633(f) shall:

> When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. If the earlier filed application is not in English, the requirements of § 1.647 must also be met.

Section 1.647 of 37 CFR states:

> When a party relies on a document or is required to produce a document [is] in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

Clearly, as Tamai filed a motion for benefit of the filing date of its PCT application, which was in Japanese, Tamai was required to file a translation of the PCT application along with the motion. This Tamai did not do.

In regard to Tamai's argument that the '183 application is a translation of the PCT application, we note that Tamai did not state that the '183 application is a translation of the PCT application, attaching same, when the motion for benefit was filed. As such, we are not persuaded that such an alleged correspondence between the '183 application and the PCI application relieves Tamai of its obligations under 37 CFR § 1.637(f) In addition, we agree with Stevens that it is not the burden of Stevens or this tribunal to look to the '183 application and determine whether it is a translation of the PCT application. Tamai argues that the provisions of 37 CER § 1.639 obviate the need for Tamai's 1.633(f) motion to include another copy of documents already in the file wrappers of record.

The provisions of 37 CFR § 1.639 do not obviate the need for the filing of the PCT application as argued by Tamai. Section 1.639 of 37 CFR relates to evidence in support of a motion and states in relevant part that:

> . . . proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply urlle5s the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

As section, 1.639 relates to evidence needed to prove a material fact in a motion while § 1.637(f) relates to documents that are required to be filed with a motion for benefit, the provisions of § 1.637(f) are not obviated by the provisions of § 1.639.
Tamai also argues that all substantive issues were readily resolved by simply referring to the embodiments shown in Figure 1 of Tamai's PCT application which was present in the file wrapper of the '183 application.

However, it was not the obligation of Stevens to go through the '183 application, find the PCT application and review the drawings to resolve substantive issues. It was Tamai's obligation to file a copy of the translation with the motion pursuant to the provisions of 37 CFR § 1.637(f)

Tamai has not met the requirements of 37 CFR § 1.637(f).

Tamai argues that it would be in the interest of justice to accord Tamai the benefit of the filing date of the PCT application notwithstanding the fact that the motion for benefit was filed without the requisite translation of the PCT application. We do not agree.

It is true that we may, in accordance with the provisions of 37 CFR § 1.640(b) take such other actions as will secure the just, speedy and inexpensive determination of the interference. However, we do not consider the granting of a motion for benefit of a PCT application which was filed without a copy of the translation of that PCT application to be in the interest of a just, speedy and inexpensive determination of the interference.

First, Stevens is entitled to review a translation of the PCT application at the time the motion was filed to determine

how to respond to the motion. In addition, Stevens is entitled to expect that the rules of this tribunal will be followed by all parties to this interference.

Finally, we address Tamai's argument that it is inconsistent to accord Tamai the benefit of the Japanese Patent Application No. 3—68371 ("JP 371') and not accord Tamai the benefit of the PCT application. As we stated in our decision, Stevens was in possession of a translation of the JP '371 application at the time the motion was filed and was not in possession of the translation of the PCT application. As such, in our view, any inconsistency in the treatment of the JP 371 application and the PCT application arises because of Tamai's inconsistent actions in regard to these two applications.

The request for reconsideration is granted to the extent that we have reconsidered our decision but denied in that we decline to make any modifications to our decision.

_____/s/_____
Muriel E.Crawford
Administrative Patent Judge

_____/s/_____
Sally Gardner-Lane
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

_____/s/_____
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Administrative Patent Judge

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

03-1479

(Interference No. 103,662)

CHRISTOPHER J. STEVENS,

Appellant,

V.

SHIGERU TAMAI,

Appellee.

ORDER

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLEE, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on June 25, 2004.

FOR THE COURT,
_____/s/_____
Jan Horbaly
Clerk
Dated: June 10, 2004
cc: Carl E. Moore, Jr.
Edward Kenehan, Jr.

STEVENS V TAMAI, 03-1479
(PTO - 103,662)